

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
Attorney Docket No.: 14446US02**

In the Application of:

Jeyhan Karaoguz, et al.

Serial No.: 10/672,664

Filed: September 26, 2003

For: MEDIA EXCHANGE NETWORK
SUPPORTING DELIVERY OF MEDIA
CONTENT TO AUTHORIZED
VEHICLES VIA MEDIA
PROCESSING SYSTEM

Examiner: Luong, Alan H.

Group Art Unit: 2427

Confirmation No.: 9798

Electronically Filed On June 1, 2011

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
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Sir:

This Paper responds to the Examiner's Answer mailed April 29, 2011. For at least the reasons set forth in the Appeal Brief and this Reply Brief, the Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-7, 9-18, 20-34, and 36-61 of the present application.

REMARKS

The Applicants note that the Examiner's Answer provides essentially the same reasoning as the Final Office Action. *Compare* Examiner's Answer at pages 3-24 *with* September 1, 2010 Final Office Action at pages 6-27. Accordingly, the Appeal Brief addresses these arguments at pages 9-21. To the extent that the Examiner's Answer presents new issues or arguments, the Applicants will address below.

A recent Federal Circuit case clarifies the nature of a *prima facie* case of unpatentability. In particular, *In re Kao* states that the "examiner bears the initial burden of presenting a *prima facie* case of obviousness. *See In re Glaug*, 283, F.3d 1335, 1338 (Fed. Cir. 2002)." *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (attached). Moreover, the Examiner must support conclusions of obviousness with "**substantial evidence**." *See id.* (emphasis added). "Substantial evidence is such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *In re Kumar*, 418 F.3d 1361, 1366-67 (Fed. Cir. 2005). However, "conjecture does not supply the requisite substantial evidence to support the rejections" *See In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011). Further, conclusory reasoning does not supply the requisite substantial evidence. *See In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) ("the Board should neither rely upon conclusory reasoning nor its own conjecture in assessing the weight of evidence"). As explained in the Appeal Brief, neither the Final Office Action, nor the Examiner's Answer, support conclusions of obviousness with "substantial evidence."

I. The Proposed Combination Of Lee And Lavelle Does Not Render Claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, 60, And 61 Unpatentable

The Applicants first turn to the rejection of claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, 60, and 61 as being unpatentable over Lee in view of Lavelle. The Applicants explain in detail that the Final Office Action and Examiner's Answer fail to provide "substantial evidence" to support the rejections of claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, 60, and 61 for a variety of reasons. *See* Appeal Brief at pages 10-17.

A. Independent Claims 1, 14, And 31

1. Set Top Box Circuitry Remote From A Vehicle

The Examiner maintains that the “Gateway 30” of Lee is the same as the “set top box circuitry,” as recited in claim 1. *See* Examiner’s Answer at pages 25-26. However, the Applicants explain why this reasoning is in clear error. *See* Appeal Brief at pages 11-13. Notably, the Examiner’s Answer also acknowledges that the “gateway 30 is not A Set-top box” *See* Examiner’s Answer at page 25. Yet, the Examiner’s Answer concludes, without any concrete or substantial evidence, that the “Gateway 30 has the same hardware structure as set-top box circuitry.” *See id.*

Again, though, the Examiner’s Answer provides no evidence to support this conclusion. *See* Examiner’s Answer at pages 25-26. Instead, it is seemingly based on the Examiner’s subjective opinion and conclusory reasoning. As set forth in *In re Kao*, however, conclusory reasoning does not supply the requisite substantial evidence required to support a *prima facie* case of unpatentability. *See In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011).

Additionally, the Examiner’s Answer attempts to differentiate between “set top box circuitry” and a “set top box.”¹ *See* Examiner’s Answer at page 26. However, this is not relevant to the issue of whether the Gateway 30 of Lee is, includes, or is analogous to “set top box circuitry.” Again, the Examiner has provided absolutely no evidence to support the conclusion that “Gateway 30 has the same hardware structure as set-top box circuitry.”

As explained in the Appeal Brief and above, Lee does not describe, teach or suggest “set top box circuitry” remote from a vehicle and a vehicle system, in particular, or “set top box circuitry,” in general, as the Office Action contends. Thus, the Office Action has failed to demonstrate that the cited references expressly or necessarily describe, teach, or suggest “set top box circuitry communicatively coupled to the storage, the set top box circuitry arranged to exchange media via a communication network using a first communication interface, the set top

¹ The Applicants previously indicated that “if the Examiner and supervisor believe that amending to ‘set top box’ instead of ‘set top box circuitry’ would expedite prosecution towards allowance, the Applicants would agree to such an Examiner’s Amendment.” *See* December 1, 2010 Second Pre-Appeal Brief Request for Review at page 4. However, this offer to avoid the present Appeal and expedite prosecution was seemingly disregarded.

box circuitry supporting wireless communication of media using a second communication interface, the set top box circuitry being remotely located from the authorized vehicle,” as recited in claim 1, “at least one vehicle system within the authorized vehicle remotely located from and communicatively coupled to the set top box circuitry, the at least one vehicle system comprising an entertainment system,” as recited in claim 14, or “set top box circuitry arranged to exchange media via a communication network, wherein the set top box circuitry is coupled to at least one vehicle system comprising an entertainment system, said set top box circuitry being remotely located from the authorized vehicle,” as recited in claim 31.

Thus, for at least these reasons, the Final Office Action and the Examiner’s Answer fail to establish a *prima facie* case of unpatentability with respect to claims 1, 14, 31, and the claims depending therefrom.

Additionally, the Applicants previously requested the following:

Therefore, if the current rejection is maintained, the Applicants respectfully request that the Examiner’s Answer: 1) **identify the specific Rationale** (i.e., by **specifically indicating** one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejection so that the Applicants may more clearly address the Examiner’s concerns, and 2) **state on the record** the **required** factual findings to support the Rationale that the Examiner has chosen.²

See Appeal Brief at page 19.

In response, the Examiner points to “KSR guideline (B).” See Examiner’s Answer at page 26.

With respect to this Rationale, however, the MPEP states the following:

To reject a claim based on this rationale, Office personnel **must** resolve the *Graham* factual inquiries. Then, Office personnel **must** articulate the following:

² Indeed, the Applicants respectfully requested such an explicit analysis and associated factual findings for **each and every rejection** under 35 U.S.C. § 103 of any of the pending claims, as required by current PTO practice. **However, the Examiner’s Answer only mentions a Rationale with respect to the limitation of claim 1 noted above.**

- (1) a finding that the prior art contained a device (method, product, etc) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
- (2) a finding that the substituted components and their functions were known in the art;
- (3) a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; ...

See MPEP at 2143(B) (emphasis added).

In this case, the Examiner's Answer simply concludes "according to simple substitution of one known element for another to obtain predictable results" *See* Appeal Brief at page 26. For example, the Examiner's Answer provides no evidence that one of ordinary skill in the art could have substituted one known element for another, and that the results of the substitution would have been predictable, as required by the MPEP. It's not enough to simply conclude, without any evidence, a "simple substitution" and "predictable results."

Again, the Examiner must support conclusions of obviousness with "**substantial evidence.**" *See In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (emphasis added). "Substantial evidence is such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *In re Kumar*, 418 F.3d 1361, 1366-67 (Fed. Cir. 2005). However, "**conjecture does not supply the requisite substantial evidence to support the rejections**" *See In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (emphasis added). Further, conclusory reasoning does not supply the requisite substantial evidence. *See In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) ("the Board should neither rely upon conclusory reasoning nor its own conjecture in assessing the weight of evidence").

However, the Examiner's Answer fails to provide any actual evidence (as opposed to subjective, conclusory opinion) of a simple substitution that would be predictable.

Further, with respect to the *Graham* factual inquiries, the Examiner's Answer does not attempt to "resolv[e] the level of ordinary skill in the pertinent art." Instead, the Examiner's Answer simply summarily concludes that "it would have been obvious ..." and vaguely notes "a person of ordinary skill in the art." *See* Examiner's Answer at page 8, for example. However, the Office Action fails to actually resolve the level of ordinary skill in the art. It is not enough to

simply vaguely state “one of ordinary skill in the art.” Again, the Examiner must support conclusions of obviousness with “**substantial evidence.**” See *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (emphasis added).

Thus, for at least these reasons, the Final Office Action and the Examiner’s Answer fail to establish a *prima facie* case of unpatentability with respect to claims 1, 14, 31, and the claims depending therefrom.

2. Personal Channel Operative To Download A Video Game

Additionally, Lee does not describe, teach or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system,**” as explained in the Appeal Brief at pages 13-14.

Neither Lee, nor Lavelle, describes, teaches, or suggests that video games are downloaded to the entertainment system or a handheld game system through an external source. Indeed, there is absolutely nothing in the references that expressly or necessarily describes, teaches, or suggests such a limitation. Consequently, the combination of the two references cannot describe, teach, or suggest such a feature. That is, if neither limitation is taught in Lee or Lavelle, an aggregation of the two references cannot somehow yield a limitation that is found in neither. Therefore, the proposed combination of Lee and Lavelle does not describe, teach, or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry [which is remote from the vehicle], via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system,**” as recited in claims 1, 14, and 31.

Thus, for at least these reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to claims 1, 14, 31, and the claims depending therefrom.

B. Claims 11, 22, And 38

The Applicants explain in detail that the Final Office Action and Examiner’s Answer fail to establish a *prima facie* case of unpatentability with respect to claims 11, 22, and 38. See Appeal Brief at pages 14-15.

In short, the Office Action fails to show where any of the cited references expressly or necessarily describes, teaches, or suggests “wherein the **authorization information is supplied by the at least one media peripheral** [that is interfaced to the at least one vehicle system].”

C. Independent Claim 25

Independent claim 25 recites, in part, “facilitating a transfer, via the vehicle system, of a video game from a source that is remote from the authorized vehicle to one or both of the entertainment system and/or a handheld electronic game system.” The Applicants explain in detail that the Final Office Action and the Examiner’s Answer fail to demonstrate that the cited references expressly or necessarily describe, teach, or suggest these limitations. *See* Appeal Brief at pages 15-16. *See also* above at Section I.A.2.

Neither Lee, nor Lavelle, describes, teaches, or suggests that video games are transferred to an entertainment system or a handheld electronic game system through a remote source. Indeed, there is nothing in the references that expressly or necessarily describes, teaches, or suggests such a limitation. Consequently, the combination of the two references cannot describe, teach, or suggest such a feature.

The proposed combination of Lee and Lavelle does not describe, teach, or suggest “facilitating a transfer, via the vehicle system, **of a video game from a source that is remote from the authorized vehicle** to one or both of the entertainment system and/or a handheld electronic game system,” as recited in claim 25.

Thus, for at least these reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to claims 25 and the claims depending therefrom.

D. Dependent Claims 40, 46, And 58

Claim 40 recites, in part, “wherein the at least one vehicle system comprises a navigation system, the at least one view comprising a second personal media channel that facilitates a user-defined navigation update to the navigation system.” Claims 46 and 58 recite similar limitations. The Applicants explain in detail that the Office Action fails to demonstrate that the cited references expressly or necessarily describe, teach, or suggest these limitations. *See* Appeal Brief at pages 16-17.

The Examiner relies on Lee as disclosing these limitations. *See* Examiner's Answer at pages 13 and 32. As explained in the Appeal Brief, however, such reliance is in clear error.

While Lee discloses location information from the GPS receiver and the gateway 30 providing mapping services, Lee does not describe, teach or suggest "a second **personal media channel** that facilitates a **user-defined navigation update** to the navigation system." **Lee simply does not describe, teach or suggest a user defining a navigation update, in general, or one through another personal media channel, in particular.**

The Office Action fails to demonstrate that any of the cited references expressly or necessarily describes, teaches, or suggests "wherein the at least one vehicle system comprises a navigation system, the at least one view comprising a second personal media channel that facilitates a user-defined navigation update to the navigation system," as recited in claim 40, for example. Thus, for at least these additional reasons, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of unpatentability with respect to claims 40, 46, and 58.

II. The Proposed Combination Of Lee, Lavelle, And Witkowski Does Not Render Claims 41, 47, And 59 Unpatentable

The Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claims 41, 47, and 59 for at least the reasons set forth above with respect to claims 1, 14, and 31.

III. The Proposed Combination Of Lee, Lavelle, And Novak Does Not Render Claims 25-30, 52, 54, And 55 Unpatentable

The Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claims 25-30, 52, 54, and 55 for at least the reasons set forth above with respect to claims 1, 14, and 31.

Additionally, the Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claim 52 for at least the reasons set forth above with respect to claims 40, 46, and 58.

IV. The Proposed Combination Of Lee, Lavelle, Novak, And Witkowski Does Not Render Claim 53 Unpatentable

The Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claim 53 for at least the reasons set forth above with respect to claim 25.

V. CONCLUSION

For at least the reasons discussed above, the Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-7, 9-18, 20-34, and 36-61.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: June 1, 2011

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